

Attorney Docket No. (AMENDED): 14673-028USC1
Application No. 10/726,960
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REMARKS

The Office Action dated November 16, 2005 has been reviewed, and the comments of the U.S. Patent Office have been considered. The specification has been amended. Claims 1-33 are pending and claims 16 and 18 are amended. Applicant asserts that in view of the arguments presented herein, the application is in condition for allowance over the prior art of record. Examination of the pending claims is earnestly solicited.

Paragraph 0024 is requested to be amended to correct a description of the slight angle the helical fiber winding may create relative to the longitudinal fibers. The only changes are in the penultimate sentence of that paragraph. The changes are supported by the figures and paragraph 0005, which clearly states that the ten degree angle is with respect to the perpendicular, not the longitudinal fibers. Claim 16 is amended to make it consistent with amended paragraph 0024, above.

Claim 18 has been amended to provide proper antecedent basis for "base layer." The amendment is presented to make the claim clearer and is not a response to the prior art or the Examiner's arguments or claim rejections.

Claims 1-17 of the present application stand rejected as claiming the same invention as claims 1-17 of co-pending Application No. 10/726,464. Applicant respectfully traverses the rejection.

The Office Action asserts that a provisional statutory-type double patenting rejection is applicable to the claims in the present application and the co-pending application.. Applicant respectfully reminds the Examiner that a statutory double patenting rejection is "avoided [if] the conflicting claims ... are not coextensive in scope." (MPEP §804.02). Claims are not coextensive if one claim reads on a posited structure which is outside the scope of the other claim. The final clauses of each of the independent claims of the alleged conflicting claims demonstrates that the claims are not coextensive in scope.

The final clauses of the independent claim of the respective present and co-pending applications recite as follows:

Application:	Claim 1 - recitation in final clause (emphasis added)
10/726,960 (the co-pending application)	wherein <u>the interior surface area</u> of the non-compliant medical balloon remains substantially unchanged when the balloon changes from a deflated state to an inflated state.
10/726464 (the present application)	and <u>the longitudinal length</u> of the non-compliant medical balloon remains substantially unchanged when the balloon changes from a deflated state to an inflated state.

Because the independent claim of the instant application can read on a posited structure that would be outside the scope of the independent claim of the co-pending application, the claims are not coextensive. Therefore, Applicant respectfully requests that the provisional statutory-type double patenting rejection be withdrawn.

Claims 1-12, 15-17 stand rejected under 35 U.S.C. 102(b) as being anticipated by Hamlin (5,270,086). Hamlin shows and describes a multi-layer balloon, however, Hamlin fails to teach or suggest the claimed invention as a whole. Hamlin describes a tensile layer and a bonding layer. *See* col. 2, ll. 9-18. Hamlin describes various exemplary materials for these layers. *See e.g.* col. 2, ll. 31- 68. None of these exemplary materials show or describe the fiber layers recited in claims. Thus, Hamlin fails to teach or suggest the claimed invention as a whole that recites first and second fiber layers.

Even though Hamlin fails to show or describe the claimed fiber layers, the Examiner alleges that Hamlin contains a recitation of a "first fiber layer [that] comprises inelastic fibers" by the description of the exemplary materials in col. 2, ll. 31- 68 of Hamlin. Contrary to the Examiner's assertion, the cited portion of Hamlin does not indicate that such layers contain fibers.

Claims 18-33 stand rejected as anticipated by Euteneuer (US 4,952,357). Euteneuer describes a balloon and a method of making a balloon in which one or more layers of polyimide are formed by depositing polyamine over a substrate and curing to form one or more polyimide layers. The substrate is dissolved leaving the layers of polyimide to form the balloon. *See* col. 3,

ll. 16-33 and Fig. 2B. Euteneuer also teaches that a layer of metal may be deposited between the polymer layers. *See* col. 3, ll. 59-65 and Fig. 4. Euteneuer fails to show a first fiber parallel to a longitudinal axis or a second fiber wound radially over a base. Thus, Euteneuer fails to teach or suggest the claimed invention as a whole.

Even though Euteneuer fails to show or describe the claimed first and second fibers, the Examiner alleges that Euteneuer contains the recitation “a first fiber positioned in parallel relation to a longitudinal axis ... (fig 2b), a second fiber wound radially over the base layer along at least a portion of its longitudinal axis,” citing Euteneuer; col. 1 lines 65-68 and Fig. 2b. Contrary to the Examiner’s assertion, the cited figure and text describe a polyimide balloon deposited over a substrate and do not show fibers or fiber position as defined by the claims.

To the extent that the Examiner believes the claimed fibers or fiber layers are inherently disclosed by Hamlin and/or Euteneuer, Applicant requests that the Examiner meet the burden of such assertion, as set forth in the MPEP.

MPEP §2112-IV states: “In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” The Office Action contains no such reasoning. Applicant hereby respectfully requests that such reasoning be provided, or the rejection of the pending claims over Hamlin be withdrawn..

On the other hand, if the Examiner proposes to take “Official Notice” that the described materials of Hamlin and/or Euteneuer describe the claimed fibers or fiber layers, Applicant respectfully requests that the Examiner produce evidence to support such a fact finding, and provide Applicant an opportunity to rebut it. *See* MPEP 2144.03.

Moreover, if the Examiner is able to establish that the materials described by Hamlin for one of the described layers of the Hamlin balloon provides a fiber layer, Hamlin teaches different properties and different exemplary materials for each of its tensile and bonding layers. *See* col. 2, ll. 31 – 68. As such, Hamlin does not show or describe both the first and second fiber layers, as recited in rejected claims 1-17. For example, if the Examiner is able to establish that the outer layer of the balloon of Hamlin that is described as a biaxially-oriented film inherently

contains fibers to provide the claimed first fiber layer, it would not follow that the inner layer of the balloon of Hamlin, which is of different materials, would contain fibers. Therefore, such an argument would fail to show the claimed second fiber layer. Thus, the claimed first and second fiber layers are not taught or suggested by Hamlin regardless of the Examiner's assertion with respect to the materials described by Hamlin. Thus, Hamlin fails to teach or suggest the claimed invention as whole.

Claims 2-17 and claims 19-33 depend, either directly or indirectly from claims 1 and 18, respectively, and should be allowable for the reasons discussed above as well as for the further recitation they contain.

Claims 14 and 15 stand rejected under 35 U.S.C. §103(a) as obvious over Hamlin in view of Trotta et al (5,290,306). Claims 14 and 15 depend from claim 5 and therefore incorporate the features of claim 5 and the base claim 1. The cited reference, Trotta, whether considered alone or in combination with Hamlin, fails to teach or suggest to one of ordinary skill in the art, the features of fibers or fiber layers, as discussed above. Thus, the secondary reference fails to cure the deficiency of Hamlin. Accordingly, Applicant submits that claims 14 and 15 are allowable because Hamlin, alone or in combination with Trotta, fail to teach the or suggest the claimed invention as a whole.

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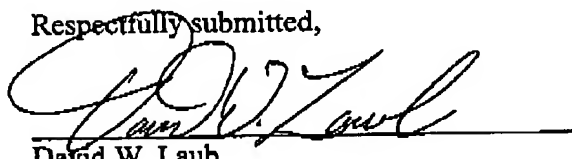
CONCLUSION

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration of this Application and the prompt allowance of claims 1-33.

Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact the undersigned to expedite prosecution of the application.

The Commissioner is hereby authorized by this paper to charge any fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account 50-3081. **This paragraph is intended to be a CONSTRUCTIVE PETITION FOR EXTENSION OF TIME in accordance with 37 C.F.R. § 1.136(a)(3).**

Respectfully submitted,



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